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bar code appearing on a facsimile of the video product packaging, means for scanning a video product bar code appearing on a video product promotional material,] and means for scanning a label containing the video product code affixed to the video product[, and combinations thereof].

Please cancel claims 92-116, directed to CD-ROM information products, without prejudice to the filing of a continuation or a continuation in part application to prosecute these embodiments.

REMARKS

The applicant thanks the Examiner for the courtesy of the interview held on October 21, 1993.

Applicant confirms its intention to prosecute claims 14 through 117, as shown in the Third Preliminary Amendment filed in this case on August 4, 1993. However, the claims directed to "software products" (Claims 40-65) and to "CD-ROM products" (claims 92-116) have been cancelled without prejudice to their presentation in subsequent continuation or continuation in part applications.

The Examiner has rejected the claims (claims 66 through 91) directed to video products under 35 U.S.C. § 112, first paragraph, as failing to satisfy the written description requirement.<sup>1</sup> Applicant respectfully traverses this rejection.

The purpose of the written description requirement is to insure that the subject matter presented in the form of a claim after the the date of application was sufficiently disclosed at the time of filing so that the prima facie date of invention can be held to be the filing date of the application. In re Smith, 481 F.2d 910, 178 USPQ 620 (CCPA 1971). The test for sufficiency of support is whether the disclosure of the application relied upon reasonably conveys to the artisan that the inventor had possession at that time of the later claimed invention. Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 19 USPQ2d 1111 (Fed. Cir. 1991). Precisely how close the original description must come to comply with the description requirement must be determined on a case-by-case basis. Ralston Purina Co. v. Far-Mar-Co., Inc. 772 F.2d 1570, 227 USPQ 177 (Fed. Cir. 1985).

It is clear that the original application described the use of the invention to preview audio CD products as merely an example of the invention. The original

<sup>1</sup> These claims have not been rejected on the grounds of lack of enablement.

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claims were directed to the broad category "information products". To one of ordinary skill in the art, reviewing the original specification, it would have been clear that the presently claimed method for previewing video products was intended to fall within the definition of "information products". No other conclusion is possible. The original intention was to provide a system which would enable a consumer to preview an information product such as audio CDs, video products and software, without requiring the consumer to somehow load the product into the previewing device.

Applicant further relies upon the art of record, particularly the Freeney patent, U.S. Patent No. 4,528,643. This patent is evidence that the state of the art was such that the artisan would know "information products" was intended to describe the specific system now claimed directed to video products, as well as applications to other products such as software. There is no question that the applicant had this invention in his possession at the time the application was originally filed. Otherwise, he would not have used language to the effect that the audio CD application was merely illustrative of the way in which the invention could be applied to preview information products, including the presently claimed system for previewing video products. Applicant also notes that Gould et al., U.S. Patent No. 4,414,467, was cited against the originally filed claims. Since Gould et al. was directed to video products, even the Examiner understood the original claims to include video product previewing. The written description requirement to support claims 66 through 91 has been met, and this rejection should be withdrawn. Uter v. Hiraga, 845 F.2d 993, 6 USPQ2d 1709 (Fed. Cir. 1988).

Claims 20-21, 46-47 (now moot because these claims have been cancelled), 72-73, 98-99 (now moot because these claims have been cancelled) are rejected under 35 U.S.C. § 112, second paragraph, because according to the Examiner, it is not clear what an identification or selection-choice "event" is. Applicant traverses the rejection.

In claim 20, music product identification "events" are clearly intended to refer to the action taken by the system user according to element (c) of claim 14: "means for enabling the user to identify to the system the music product to be previewed." "Event" is intended to reflect each time that the user identifies a product. The same argument applies to claim 46.

In claim 21, the term "selection-choice" event is intended to refer to the action required by element (d) of claim 14: "means for user-interaction with the system enabling the user to choose among musical selections from the music product identified to the system for previewing, and enabling the user to maintain control of

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the musical selection playback throughout the duration of the musical selection playback." The means set forth in claim 21 is intended to record the user's choice of the musical product selections available for preview. The same argument applies to claim 73.

Claims 26, 78 and 103 are rejected on the grounds that it is unclear how the recited steps relate back to "existing reference" in the preceding claims. Applicant traverses. These claims have been amended to depend from the corresponding independent claims rather than from the immediately preceding claims. This amendment obviates this basis for rejection.

Claims 28 and 80 stand rejected because, according to the Examiner, it is not clear what data is being uploaded or downloaded. Applicant traverses. The respective preceding independent claims provide a system including "data storage, retrieval and playback means containing preloaded data and... providing for storage of data generated and collected during user operation of the system." The intent of the subsequent claims, represented in this argument by claim 28, is to enable uploading of data related to the products available for sale and downloading of data gathered during user operation of the system.

6. Without acquiescing in the Examiner's reasoning for the double patenting rejection, applicant will submit an appropriate terminal disclaimer within the next two weeks.

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PATENTCONCLUSION

Applicant submits that all of the Examiner's rejections have been overcome. This application should be promptly passed to issue.

Respectfully Submitted,  
DERGOSITS & NOAH

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